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10/531,467	04/15/2005	Osamu Kawai	270649US0PCT	1368

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EXAMINER	
BERNSHTEYN, MICHAEL	

ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/531,467	KAWAI ET AL.	
	Examiner	Art Unit	
	Michael M. Bernshteyn	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION..

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-7,9-14 an 16-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7,9-14 an 16-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action follows a response filed on November 15, 2007. Claims 1, 3-7, and 9-19 have been amended; claim 15 has been cancelled; no claims have been added.

2. In view of the amendment and remarks, the rejection of claims 1, 3-6 and 9-19 under 35 U.S.C. 112, 1st paragraph; the rejection of claim 7 under 35 U.S.C. 112, 2nd paragraph; the rejection of claims 1, 3-7, 9-14 and 16-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masuda et al. (JP 2002-256128), and the rejection of claims 9-14 under 35 U.S.C. 102(b) as being anticipated by Hirota et al. (WO 02/39153 or its equivalent the U.S. Patent 6,941,056) have been withdrawn.

3. Applicant's arguments with respect to claims 1, 3-7 and 9-19 have been considered but are moot in view of the new ground(s) of rejection.

4. Claims 1, 3-7, 9-14 and 16-19 are pending.

Claim Rejections - 35 USC § 112, 2nd paragraph

5. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

6. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites, "...further comprising the step of cutting and polishing to form an edge on the resin plates which is a light entrance." It is indefinite

because it is not clear as to the meaning of "a light entrance". The specification does not further define "a light entrance". Therefore, this terminology is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 103

7. The test of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

8. Claims 1, 3-7, 9-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al. (JP 2002-256128) in view of Sakamoto (U. S. Patent 5,726,268).

With regard to the limitations of claims 1 and 3-7, Masuda discloses methacrylic resin composition with inorganic particles, which are selected from the group consisting of **silica, titanium oxide, barium sulfate, calcium carbonate, methacrylic resin, styrene resin, and silicone resin**, or two sorts or more (page 2, [claim 2]). The composition contains 100,000-1,000,000 fine particles having particles size of **0.5-1.0 μm**, which is within the claimed ranges. The composition is suitable for producing a backlight of a homogeneous liquid crystal display exhibiting a high luminance and a low unevenness in luminance (abstract). Masuda discloses that **methyl methacrylate polymer** comprising methyl methacrylate units as a primary component, preferably not less than 70% by weight. Methyl methacrylate units may partially be replaced by a **monofunctional unsaturated monomer** unit, which is copolymerizable with

methyl methacrylate. The content of the copolymerizable, monofunctional unsaturated monomer unit in the polymer is preferably not less than 0.2% by weight, which is within the claimed range. Examples of copolymerizable, monofunctional unsaturated monomer which forms the monofunctional unsaturated monomer unit include: **2-ethylhexyl methacrylate**, 2-hydroxyethyl methacrylate, butyl methacrylate, benzyl methacrylate, **methyl acrylate, ethyl acrylate, propyl acrylate, butyl acrylate,** etc. Example of the **polyfunctional methacrylate** includes neopentyl glycol methacrylate (page 4, [0013]).

With regard to the limitations of claims 1 and 19, Masuda discloses that the edge light method using the transparent material which has arranged the light source on the side face as structure of such the surface light source (pages 2-3, [0003]).

With regard to the limitations of claims 1, Masuda does not disclose that the content of ethylenedlycol dimethylacrylate in the mixture is in the amount of 0.15 to 2 parts per 100 parts by weight of the polymerizable material.

Sakamoto discloses that examples of the polyfunctional monomer include: esters of ethylene glycol and of oligomers of ethylene glycol having two or more hydroxyl groups esterified by acrylic acid or methacrylic acid, such as **ethylene glycol di(meth)acrylate**, diethyene glycol di(meth)acrylate, triethylene glycol di(meth)acrylate, neopentyl glycol methacrylate, etc. (col. 4, lines 20-43). The amount of ethylene glycol di(meth)acrylate is within the claimed range (example 1, col. 7, line 64 through col. 8, line 2).

Therefore, all of the above polyfunctional monomers are functional equivalents and can be substituted by each other. Thus, Sakamoto recognizes the equivalency of neopentyl glycol methacrylate used by Masuda and ethylene glycol di(meth)acrylate as the polyfunctional monomers for resin compositions for lighting guide. In the instant case the substitution of equivalents of polyfunctional monomers requires no express motivation, as long as the prior art recognize equivalency, ***In re Fount***, 213 USPQ 532 (CCPA 1982); ***In re Siebentritt***, 152 USPQ 618 (CCPA 1967); ***Graver Tank & Mfg. Co. Inc. V. Linde Air Products Co.*** 85 USPQ 328 (USSC 1950), and a person skilled in the art would have found obvious to substitute neopentyl glycol methacrylate of Masuda for ethylene glycol di(meth)acrylate in the adjusted amount as taught by Sakamoto based on their recognized equivalency and with the reasonable expectation of success.

With regard to the limitations of claims 9-14, Masuda discloses the transparent material, which can be produced using the mixture of methacrylic resin and particles by injection molding, extrusion molding, etc. which carry out melting kneading and are generally used (page 6, [0020]). The dispersing agent (particle) shown in table 1 was added in examples 1-8 to methacrylic resin, kneading extrusion and the extruded strand were palletized with the extruder with the temperature 240^{0}C and screw speed 200 rpm (page 6, [0023]-[0026], Table 1, page 8, [0028]).

9. Claims 1, 3-7, 9-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirota et al. (WO 02/39153) in view of Hasegawa et al. (JP 60-258219). The U.S. Patent 6,941,056 is equivalent to the WO 02/39153; therefore, the following rejection is based upon the context of U.S. Patent 6,941,056.

With regard to the limitations of claims 1, 6, 7 and 16, Hirota discloses **a light guiding plate**, characterized by comprising a transparent thermoplastic resin composition containing **1-200 ppm** of fine particles having a refractive index of 1.7-3.0 and an average **particle diameter of 0.01-1.0 μm**, which is within the claimed range (abstract). In the drawing, A indicates a light source (a cold cathode-ray tube), B indicates a lamp house, C indicates a light guiding plate containing fine particles wherein the fine particles are not drawn to scale, D indicates a light reflective sheet, E indicates a light diffusing sheet, and F indicates a prism sheet. FIG. 2 shows a flow chart of an embodiment of the method of forming the light guiding plate (col. 2, lines 43-50).

As the methacrylic resins, there may be used copolymers of methyl methacrylate or ethyl methacrylate with a monomer copolymerizable therewith. The amount of methyl methacrylate or ethyl methacrylate is preferably not less than 70% by weight based on the weight of the copolymer. Examples of the monomer copolymerizable with methyl methacrylate or ethyl methacrylate are methacrylate esters such as butyl methacrylate, ethyl methacrylate, propyl methacrylate, cyclohexyl methacrylate phenyl methacrylate, 2-ethylhexyl

methacrylate, etc.; acrylate esters such as methyl acrylate, ethyl acrylate, **butyl acrylate**, cyclohexyl acrylate, phenyl acrylate, 2-ethylhexyl acrylate, etc. (col. 2, line 66 through col. 3, line 14).

With regard to the limitations of claim 1, Hirota does not disclose the usage of polyfunctional (meth)acrylate.

Hasegawa discloses a uniform methacrylic partial polymer consisting of (A) monomethylenically unsaturated monomer consisting essentially of methyl methacrylate in the amount of 90-99.7% by weight, and (B) crosslinking monomer, preferably **ethylene glycol di(meth)acrylate**, neopentyl glycol di(meth)acrylate, pentaerythritol tri(meth)acrylate and trimethylolpropane tri(meth)acrylate, which is hardened under pressing and heating conditions in the presence of a radical polymerization initiator in a mold (abstract).

Both references are analogous art because they are from the same field of endeavor concerning polymerizable methacrylate compositions for light guiding plate.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate polyfunctional (meth)acrylate such as ethylene glycol di(meth)acrylate, as taught by Hasegawa in Hirota's thermoplastic resin composition for the light guiding plate in order to obtain the composition having low birefringence and improved strength and solvent resistance, by hardening the methacrylic partial polymer consisting

essentially of methyl methacrylate and the crosslinking monomer (JP'219, abstract), and thus to arrive at the subject matter of instant claim 1.

With regard to the limitations of claims 3 and 4, Hirota discloses that the fine particles have no special limitations, and examples thereof are aluminum trioxide, titanium **dioxide**, etc. (col. 5, lines 29-33).

With regard to the limitations of claim 5, Hirota discloses that as the transparent thermoplastic resin contained in the transparent thermoplastic resin composition, mention may be made of methacrylic resins, polycarbonate resins, **styrene resins**, cyclic olefin resins, amorphous **polyesters**, etc. Preferred are methacrylic resins, polycarbonate resins and cyclic olefin resins, and more preferred are **methacrylic resins** (col. 2, lines 59-65).

With regard to the limitations of claims 9-14, Hirota discloses that the method for producing the transparent thermoplastic resin composition has no special limitation as far as the fine particles are uniformly dispersed in the transparent thermoplastic resin. However, preferably, the fine particles are previously uniformly dispersed in an organic liquid and the transparent thermoplastic resin composition is produced using the resulting dispersion. That is, for producing the transparent thermoplastic resin composition constituting the light guiding plate, it is preferred to uniformly disperse the fine particles in the transparent thermoplastic resin by previously dispersing the fine particles in an organic liquid. Furthermore, for uniformly dispersing the fine particles in the organic liquid, it is preferred to use an ultrasonic wave generating apparatus (col.

5, lines 42-55). As methods for uniformly dispersing the fine particles in the transparent thermoplastic resin in the production of the transparent thermoplastic resin composition containing the transparent thermoplastic resin and the fine particles, the following methods can be exemplified (see col. 6, line 12 through col. 7, line 14).

Hjirota also discloses that the method for molding the light guiding plate has no special limitation, and there may be employed known methods, for example, (1) a method **of molding the transparent thermoplastic resin composition to a sheet by a sheet molding extruder or a press molding machine**, cutting the resulting sheet to a desired size, and subjecting the cut surface to abrasive working, (2) a method of molding the transparent thermoplastic resin composition by an injection molding machine having a mold, and (3) a method of dispersing the fine particles in a syrup containing a starting monomer for the transparent thermoplastic resin or a partial polymer, then polymerizing the monomer or the partial polymer by a casting method to obtain a **sheet-like molded article**, then cutting it to a desired size, and subjecting the cut surface to abrasive working. In case the light guiding plate is obtained by molding the transparent thermoplastic resin composition by a sheet molding extruder, a press molding machine, an injection molding machine having a mold, etc., from operational and economical view points, there may be employed a method including the steps of preparing a master batch pellet which has a higher concentration of the fine particles in the thermoplastic resin composition than the

desired concentration and diluting to the desired concentration with transparent thermoplastic resin at the time of molding (col. 7, line 64 through col. 8, line 21).

With regard to the limitations of claims 17 and 18, Hirota does not disclose the content of the monofunctional acrylate in the polymerizable material.

It is noted that the amount of the content of the monofunctional acrylate in the polymerizable material is a result effective variable, and therefore, it is within the skill of those skilled in the art to find the optimum value of a result effective variable, as per ***In re Boesch and Slaney*** 205 USPQ 215 (CCPA 1980). See also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382: "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."

With regard to the limitations of claim 19, Hirota discloses that as the back-lighting systems, there are generally used two systems of so-called direct-light type in which the light guiding plate is interposed between a light source and a liquid crystal unit, and edge-light type in which a light source is provided at the side edge portions of the light guiding plate, and at present the edge-light type is mainly employed. Especially, with recent strong demands for high luminance display devices, large-sized display devices and thin display devices, luminous devices have been developed under the conception of making lighter, larger and thinner devices, and, among them, high luminance face luminous devices of edge-light type are especially desired (col. 1, lines 25-37)

Response to Arguments

10. Applicant's arguments filed on November 15, 2007 have been fully considered but they are not persuasive.

11. Regarding Applicants arguments that Masuda cannot teach or suggest, expressly or inherently, the benefits associated with the present invention including improved processability (for example, cutting and polishing) (page 8, 1st and the last paragraphs), it is noted that the features upon which applicant relies (i.e., improved processability, for example, cutting and polishing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, it is the examiner position to believe that the product of Masuda (see drawing 1, page 7 and abstract) is substantially the same as the sheet for light guiding plate comprising a polymer and a particulate diffusing agent recited in claim 1, even though obtained by a different process, consult ***In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).***

Since the USPTO does not have proper equipment to do the analytical test, the burden is now shifted to the applicant to prove otherwise. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a

different process." ***In re Thorpe***, *777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985*).

12. As to Applicants arguments that Masuda discloses forming materials using injection or extrusion molding (see par. [0020]) instead of forming the polymers through polymerization in a mold (as per the claimed methods) (pages 8-9, the bridging paragraph), it is noted that Masuda clearly discloses that the transparent material can be fabricated and manufactured by injection **molding**, extrusion **molding**, etc. which carry out melting kneading and are generally used (page 6, [0020]).

13. Regarding Applicants arguments that the comparative example 3 containing 10% monofunctional acrylate demonstrates the significance of the limitation that "the content of the monofunctional acrylate in the polymerizable material is 9 % by weight or less" (page 8, 2nd paragraph), it is noted that there are no examples in the table 1 (the specification, page 12) showing that the limitation of 9% by weight is critical because the examples contains no values of monofunctional acrylate between 4 and 10% by weight. Therefore, it is not clear why 9% by weight is critical, not 5%, 6%, etc. because based upon the values of table 1, any value between 4% and 10% can be critical for cutting properties.

14. Regarding Applicants arguments that Sakamoto neither teaches nor suggests that (1) ethyleneglycol dimethacrylate must be present; (2) monofunctional acrylate be present in an amount less than or equal to 9%; and (3) ethyleneglycol dimethacrylate must be present in an amount of 0.15-2% (page 9, 1st paragraph), it is noted that the above mentioned paragraph

completely contradicts with the next paragraph of remarks which states that Sakamoto's examples contain 0.030-0.079 parts by weight of ethylene glycol dimethacrylate (EGDMA)(see Table 1) (page 9, 2nd paragraph).

Furthermore, Sakamoto clearly exemplifies that ethylene glycol dimethylacrylate (EGDMA) is used in the amount of 4 parts by weight, which is within the claimed range (the polymerizable material contains, by weight: 96 parts of methyl methacrylate, 4 parts of ethylene glycol dimethylacrylate, 0.3 parts of lauroyl peroxide, 0.14 parts of n-dodecylmercaptan, 1 part of polysodium methacrylate, and 200 parts of ion-exchanged water; total amount is 301.44, and 4 parts of ethylene glycol dimethylacrylate is 1.33 parts per 100 parts by weight of the polymerizable material, which is clearly within the claimed range), (example 1, col. 7, line 64 through col. 8, line 9).

15. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., content of the polyfunctional monomer having definite concentration of the functional groups) (page 10, 1st paragraph, and the second remarks filed on November 15, 2008) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

17. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, references of Hirota and Hasegawa have analogous polymerizable methacrylate compositions comprising monoethylenically unsaturated monomer such as methyl methacrylate, etc., crosslinking monomer, which is hardened under pressing and heating in the presence of a radical polymerization initiator in a mold.

18. In response to applicant's argument that Hirota and Hasegawa is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, references of Hirota and Hasegawa are analogous art because they are from the same field of endeavor concerning polymerizable methacrylate compositions for light guiding plate and optical disk substrates.

19. In response to applicant's argument that Hasegawa discloses polyethylene glycol di(meth)acrylate having molecular weight of 170-1020, and thus, Hasegawa neither teaches nor suggest the required ethylene glycol di(methacrylate (page 11, 1st paragraph), it is noted that the specification does not discloses any molecular weight of used ethylene glycol di(methacrylate, therefore, it is not clear why Hasegawa does not teach nor suggest the required ethylene glycol di(methacrylate).

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose

telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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